

## **REMARKS/ARGUMENTS**

Claims 1-14 have been rejected. Claims 1, 10, and 11 have been amended. Claim 7 has been canceled. Claims 1 to 6 and 8 to 14 are, therefore, pending.

Favorable reconsideration of the application in view of the following remarks is respectfully requested.

### **Double Patenting**

Claims 1-14 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/011,657. The Examiner states that, although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons provided in the office action, including that the '777 application claims the obvious use of the element of the instant application. The Examiner notes that this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants herewith submit a terminal disclaimer with respect to the '777 application. This rejection is, therefore, believed moot.

### **Rejection of Claims 1-14 Under 35 USC § 112**

Claims 1-14 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that the use of the phrase "at least about" in claims 1, 7, 10 and 11 renders the claims ambiguous because the metes and bounds of the claim cannot be ascertained, MPEP § 2173.05(a). The Examiner suggests Applicants delete the term "about" from the phrase.

Applicants have amended claims 1, 10 and 11 as suggested by the Examiner. Claim 7 has been canceled.

### **Rejection of Claims 1-14 Under 35 U.S.C. §103a)**

Claims 1-14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Satoshi (JP 2000-203154) (Translation provided) in view of Pope (US 4,722,868), Shaw-Klein (US 6,110,601) and Paulson (US 6,051,306).

The Examiner states that Applicants claim an ink jet recording medium comprising (1) a support and (2) an image-receiving layer thereon including (a) porous polymeric particles and (b) a polyvinyl alcohol binder having a degree of hydrolysis of at least about 95% and having a number average molecular weight of at least about 45,000. The Examiner notes that Satoshi discloses an ink jet recording sheet comprising a substrate and an ink-receptive coating, and the substrate sheet (claims 1 and 8) is equivalent to applicants' support layer (Translation at ¶ 68). The Examiner also states that the ink-receptive coating is equivalent to applicants' image-receiving layer, comprising porous polymeric particles and a binder (Translation at ¶ 1, sub. (1)). The binder comprises a polyvinyl alcohol polymer (Translation at ¶ 22). With regard to the claimed degree of hydrolysis (claims 1 and 7) and molecular weight (claims 1 and 14) values, the Examiner states that experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results, In re Aller, 105 USPQ 233. The Examiner states that degree of hydrolysis of polyvinyl alcohol is a conventional concern in the art, for it controls the solubility and image receptive properties of the polymer, Pope at col. 3, line 57 through col. 4, line 2; Shaw-Klein at col. 3, lines 42-45. The Examiner further states that, similarly, the molecular weight of polyvinyl alcohol in an ink-receiving layer is a conventional concern in the art, for it, too controls the solubility (water resistance) of the polymer, Paulson at col. 4, lines 9-16 and lines 44-46.

The Examiner acknowledges that a *prima facie* case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good, In re Boesch and Slaney, 205 USPQ 215 and MPEP § 716.02(a). The Examiner alleges, however, that this burden has not been sustained. The Examiner acknowledges that the evidence provided in the specification suggests improved gloss characteristics when the degree of hydrolysis is 98% and the number average molecular weight is from 60,000-100,000, but that the evidence, however, is not commensurate in scope with the claims.

In order to obviate this rejection, Applicants have amended claim 1 to recite that the degree of hydrolysis of the PVA is at least 98% and the number

average molecular weight is from 60,000-100,000. Claim 1, the only independent claim in the application, is now believed allowable.

With regard to the dependent claims discussed by the Examiner, they are now believed patentable for the reason that they depend from independent claim 1.

Based on this statement, this rejection is believed obviated, as indicated by the Examiner.

Respectfully submitted,



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